



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

901

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,191	11/15/1999	DANIEL P. ORAN		3980

25181 7590 10/09/2002

FOLEY HOAG LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02110-2600

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/09/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,191

Applicant(s)

ORAN, DANIEL P.

Examiner

Donald L. Champagne

Art Unit

3622

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 41-47 is/are allowed.
- 6) Claim(s) 1-8,12-25,27,28,34,37,39 and 40 is/are rejected.
- 7) Claim(s) 9-11,26,29-33,35,36 and 38 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 November 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) Interview Summary (PTO-413) Paper No(s) _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Withdrawal of Finality

1. The finality of the last Office action (Paper No. 9 filed 5 September 2001) is hereby withdrawn. The rejection at para. 5-10 below is repeated from the last Office action. Some of the claims previously indicated to contain allowable subject matter are rejected at para. 11-12 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7, 8, 14, 19, 21-25, 27, 39 and 40 are rejected under 35 USC 102(e) as being anticipated by Bezos et al. (US Pat. 6,029,141).
6. Bezos et al. teaches a method and apparatus for facilitating and tracking personal referrals, comprising (col. 2 lines 19-47): generating a unique identifier, a *unique* associate ID (col. 2 line 42), for the pairing of an individual (col. 1 line 21) and one offer to become an associate; sending

Art Unit: 3622

to said individual an electronic-mail message that contains a web page (col. 2 lines 23-24) whose address or contents include said unique identifier or a transformation thereof; and providing in said web page instructions for building a website with referral links (col. 2 line 46), which reads on "providing in said web page a means of inputting the electronic-mail address of persons whom said individual wishes to refer".

7. Bezos et al. also teaches (claim21) a participant database (associate database 160, Col. 6 line 28), and the option to accept; (claim 23) a central controller (web server 132, p. 8 line 23); and (claim 25) a job offer and employment data, in the form of acceptance of the associate's application.
8. Claims 3, 12, 13, 15, 20, 28, 34 and 37 are rejected under 35 USC 103(a) as being obvious over Bezos et al.
9. Bezos et al. does not teach (claims 3 and 15) determining if the individual has previously been sent an electronic-mail message about the offer. However, because Bezos et al. does teach that scrutiny of associate applications is important (col. 9 lines 46-47), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine if the individual has previously been sent an electronic-mail message about the offer, which would only occur if the previous offer had been withdrawn due to failure to meet standards set for associates.
10. Bezos et al. does not teach (claims 12, 13, 20 and 37) determining if the offer is still valid and sending electronic-mail messages to persons referred by the individual. Since there would be no point in distributing invalid offers, it would be obvious to determine if a prospective offer were still valid. Since the point of getting referrals is to communicate with the referred persons, particularly to verify their orders, this also would have been obvious to one of ordinary skill in the art, at the time of the invention.
11. Claims 4-6 and 16-18 are rejected under 35 USC 103(a) as being obvious over Bezos et al. in view of Poulton et al.
12. Bezos et al. does not teach determining whether said individual had previously opted out. However, Poulton et al. discloses this feature at col.10, lines 8-19. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to include the "opting out" feature as taught by Poulton et al. into the referral system of Bezos et al. "to alleviate

the anger ... of recipients barraged by unwanted and irrelevant e-mail" (Poulton et al., col. 3 lines 55-60).

Allowable Subject Matter

13. Claims 9-11, 26, 29-33, 35, 36 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Claims 41-47 are allowed.
15. The following is an examiner's statement of reasons for the indication of allowable subject matter. For claims 9-11, 26, 36 and 38: The phrase "opt out" is disclosed at specification p. 3 lines 10-13 to mean expressing a preference to the central controller (the merchant server in the reference invention) to not receive further offers. Whereas the individual in the reference invention can opt out in the sense of terminating the application process, this would not constitute an expression of a preference not to receive further offers. (The individual in the reference invention could choose to again obtain an associates application from the merchant, which would constitute a further offer.) The reference neither teaches nor suggests opting out in the sense disclosed in the instant application.
16. For claims 29-33 and 35: The reference does not teach or suggest referring a "participant", a potential associate in the reference invention, and tracking the referral. Associates would generally be reluctant to encourage other associates since they would be creating competition for themselves. In those cases where one associate found it to their advantage to encourage another person to become an associate, the associate would simply direct the second person to the on-line application process. The merchant would have no obvious reason for tracking these associate referrals.
17. For claims 41-47: The reference invention does not utilize a database to determine at least one participant. The reference invention is intended for potential associates with special knowledge, in books, for example. It is not obvious that a worthwhile database of such people could be practicable.
18. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the

issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Examiner
Art Unit 3622

30 September 2002

